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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/664,885	09/19/2000	Richard Rubin	4138-A1	5127

7590

09/13/2002

Robert A Parsons
Parsons & Goltry
Suite 260
340 East Palm Lane
Phoenix, AZ 85004

EXAMINER

GARBE, STEPHEN P

ART UNIT

PAPER NUMBER

3727

DATE MAILED: 09/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/664,885

Applicant(s)

RUBIN, RICHARD

Examiner

Stephen Garbe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 15, 2002, has been entered.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 8-10, and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Attaway, U.S. Patent No. 5,775,530. Attaway discloses all claimed structural features including lips having a passive, non-sealing engagement at 110 and superimposed layers of cloth 300, 304 and insulating material 302. Cloth layers 300, and 304 are made from nylon, which is water impermeable plastic. The statements of function and intended use do not impart any structure to the claimed apparatus that is not disclosed by Attaway. Furthermore, claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device *is*, not what a device *does*." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (emphasis in original)

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 8-10, and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Attaway, U.S. Patent No. 5,775,530 in view of either Stewart, United States Patent No. 5,692,660 or Goryl, United States Patent No. 5,967,390. Each of Stewart and Goryl disclose containers having a layer of waterproof nylon plastic material. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make Attaway's nylon layers waterproof, as taught by either Stewart or Goryl, because waterproof material would have prevented the contents of Attaway's container from getting wet and rusting. The statements of function and intended use do not impart any structure to the claimed apparatus that is not disclosed by Attaway. Furthermore, claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device *is*, not what a device *does*." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (emphasis in original)

6. Claims 5-7, 11-13, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Attaway, U.S. Patent No. 5,775,530 in view of either Stewart, United States Patent No. 5,692,660 or Goryl, United States Patent No. 5,967,390 and further in view of Anderson et al., U.S. Patent No 4,919,300. It would have been obvious to one

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of ordinary skill in the art at the time the invention was made to provide Attaway's apparatus with hook and loop closure elements, as taught by Anderson et al. in Figure 5 (see col. 2, line 66-col. 3, line 1), because they would provide an additional measure of security to Attaway's container. Regarding the claims that require the closure elements to be supported by the lips, it is submitted that Anderson teaches this. Alternatively, the particular location would have been an obvious matter of choice.

7. Claims 5-7, 11-13, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Attaway, U.S. Patent No. 5,775,530 in view of Anderson et al., U.S. Patent No 4,919,300. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Attaway's apparatus with hook and loop closure elements, as taught by Anderson et al. in Figure 5 (see col. 2, line 66-col. 3, line 1), because they would provide an additional measure of security to Attaway's container. Regarding the claims that require the closure elements to be supported by the lips, it is submitted that Anderson teaches this. Alternatively, the particular location would have been an obvious matter of choice.

8. Applicant's arguments filed with the paper received on May 15, 2002, have been fully considered but they are not persuasive. On page 8, applicant argues that "[f]unctional recitations should be provided weight as they define the structure. The functional language directed to food and warming of food do provide limits to the structure." This argument is not persuasive because applicant does not explain what structure these functional limitations require that is not disclosed by Attaway. Attaway's foam material would help keep food warm, and the nylon material, either as disclosed

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by Attaway or as modified by either Stewart or Goryl, is water proof, thus providing the function of keeping food moist. The argument at the bottom of page 8 that there is no incentive to provide Attaway's container with a water impermeable layer is not persuasive because Attaway's container is for protecting a lantern having a metal and glass structure (col.1, lines 7-10). Thus, one of ordinary skill in the art would have been motivated to make Attaway's container water proof to prevent the metal from rusting.

9. Any inquiry concerning this application or proceeding should be directed to Stephen Garbe who can be reached at 703-308-1207. The examiner can normally be reached Monday-Thursday between the hours of 7:15 and 4:45 and alternate Fridays between the hours of 7:15 and 3:45.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee Young, can be reached on 703-308-2572.

11. The fax phone numbers for Technology Center 3700 are 703-872-9302 for papers filed in response to a non-final Office Action and 703-872-9303 for papers filed in response to a Final Office Action.

12. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist, whose telephone number is 703-308-1148.


Stephen P. Garbe
Primary Examiner
Group 3720